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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,177	11/27/2000	Frederick W. Ryan JR.	F-211	3933

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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/722,177

Applicant(s)

RYAN, FREDERICK W.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 9/21/2005 is acknowledged and entered. Claims 1, 9, 17 and 25 have been amended. Claims 1-32 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 17 and 25 recites the limitation "...by the postage metering system" in last line. There is insufficient antecedent basis for this limitation in the claim. The remaining Claims are rejected as being dependent on the rejected independent Claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 9-12, 17-20 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert (US 6,102,592) in view of Wright et al. (US 4,900,904).**

Herbert teaches a method and apparatus for postage metering system, comprising:

Independent Claims

**Claims 1 and 9,**

a computer (Fig. 5, item 20);

a printer in operative communication with the computer, the printer including an unsecure print head and a secure print head (Fig. 5, items 31 and 32; C. 1, L. 67 – C. 2, L. 7);

a control system in operative communication with the computer and the printer, the control system for executing a transaction session to generate postal data to be included in a postal indicium, the postal indicium including non-authorization data (data to be printed with visible ink) (C. 2, L. 8-13);

initiating a print request to print the postal indicium (C. 2, L. 8-13);

controlling the unsecure print head to print the non-authorization data and the secure print head to print forensic evidence of the authenticity of the postal indicia, the forensic evidence being generated by the postage metering system (C. 2, L. 8-13; C. 3, L. 31-35).

Herbert does not specifically teach an authentication unit in operative communication with the computer for executing said transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium.

Wright et al. (Wright) teaches an automated transaction system and method for a postage metering system operating in cooperation with a smart card, including the printer having a microprocessor unit (MPU) formed integrally with a print head, and a separate transaction printer; said MPU individually and uniquely controls the operation of the print head by executing an internal program which includes unique encryption algorithms parallel to those stored in the card's microprocessor, so that the printer MPU can execute a secure handshake recognition procedure with the card's microprocessor to authorize a requested transaction. With this arrangement the print head of the postage metering terminal can only be operated through the MPU, and will print a

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postmark only when the handshake recognition procedure and a postmark print command have been executed between the card MPU and the printer MPU (C. 2, L. 8-13; C. 8, L. 24-44).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Herbert to include an authentication unit in operative communication with the computer for executing a transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium, as disclosed in Wright, because it would advantageously allow to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

**Claims 17 and 24.** Said system and method, comprising:

- a computer (Fig. 5, item 20);

- a printer in operative communication with the computer, the printer including an unsecure print head and a secure print head (Fig. 5, items 31 and 32; C. 1, L. 67 – C. 2, L. 7);

- a control system in operative communication with the computer and the printer, the control system for: executing a transaction session for generating document data to be included in a document, the document data including content data (data to be printed with visible ink) (C. 2, L. 8-13);

- initiating a print request to print the document (C. 2, L. 8-13);

- controlling the unsecure print head to print the content data and the secure print head to print forensic evidence of the authenticity of the document, the forensic evidence being generated by the postage metering system (C. 2, L. 8-13; C. 3, L. 31-35).

Herbert does not specifically teach an authentication unit in operative communication with the computer for executing said transaction session between a

computer and the authentication unit to generate postal data to be included in the postal indicium.

Wright et al. (Wright) teaches an automated transaction system and method for a postage metering system operating in cooperation with a smart card, including the printer having a microprocessor unit (MPU) formed integrally with a print head, and a separate transaction printer; said MPU individually and uniquely controls the operation of the print head by executing an internal program which includes unique encryption algorithms parallel to those stored in the card's microprocessor, so that the printer MPU can execute a secure handshake recognition procedure with the card's microprocessor to authorize a requested transaction. With this arrangement the print head of the postage metering terminal can only be operated through the MPU, and will print a postmark only when the handshake recognition procedure and a postmark print command have been executed between the card MPU and the printer MPU (C. 4, L. 58-59; C. 8, L. 24-44).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Herbert to include an authentication unit in operative communication with the computer for executing a transaction session between a computer and the authentication unit to generate postal data to be included in the postal indicium, as disclosed in Wright, because it would advantageously allow to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

#### Dependent Claims

**Claims 2, 10, 18 and 26.** Wright teaches said method and system, wherein: the postal indicium further includes authorization data; and the forensic evidence of the authenticity of the postal indicia is the authorization data (the identification number of the terminal which has authorized the transaction) (C. 4, L. 67). The motivation to combine references would be to prevent fraudulent transactions by incorporating a

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security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

**Claims 3, 11, 19 and 27.** Wright teaches said method and system, wherein: the control-system is further for preventing printing by the unsecure print head until an appropriate signal is generated by the secure print head (C. 8, L. 33-35). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

**Claims 4, 12, 20 and 28.** Wright teaches said method and system, wherein: the control system is further for initiating a mutual authentication routine between the secure print head and the authentication unit; and preventing printing by the secure print head if the mutual authentication is unsuccessful (C. 8, L. 24-44). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

**Claims 5-8, 13-16, 21-24 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert in view of Wright et al. and further in view of Windel et al. (US 5,991,409).**

**Claims 5, 13, 21 and 29.** Herbert in view of Wright teaches all the limitations of Claims 5, 13, 21 and 29, including that forensic evidence of the authenticity of the postal indicia is a unique print pattern (the identification number of the terminal which has authorized the transaction) (Wright; C. 4, L. 67), except specifically teaching that the postal indicium further includes authorization data printed by the unsecure print head.

Windel et al. (Windel teaches a postage meter system and method for generating and printing a security imprint, including a "secure" print head for printing encoded

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information (C. 8, L. 4-20), and a separate printer for printing a serial number of the postage meter machine (which has authorized the transaction), said serial number is printed unencoded (C. 15, L. 11-16).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Herbert and Wright to include that the postal indicium further includes authorization data printed by the unsecure print head, because it would advantageously allow to reduce the outlay for checking mailings by allowing a directed, machine check of specific senders, or of their postage meter machines (Windel; C. 15, L. 19-25).

**Claims 6, 14, 22 and 30.** Windel teaches said method and system, wherein: the unique print pattern is a tell (mark) that is embedded within the postal indicium (C. 8, L. 4-20). The motivation to combine references would be to prevent fraudulent transactions.

**Claims 7, 15, 23 and 31.** Wright teaches said method and system, wherein: the control system is further for preventing printing by the unsecure print head until an appropriate signal is generated by the secure print head (C. 8, L. 33-35). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).

**Claims 8, 16, 24 and 32.** Wright teaches said method and system, wherein: the control system is further for initiating a mutual authentication routine between the secure print head and the authentication unit; and preventing printing by the secure print head if the mutual authentication is unsuccessful (C. 8, L. 24-44). The motivation to combine references would be to prevent fraudulent transactions by incorporating a security feature which prevents the completion of a requested transaction unless a secure handshake recognition procedure is mutually executed between the source and the terminal (Wright; C. 3, L. 5-12).



***Response to Arguments***

Applicant's arguments with respect to Claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

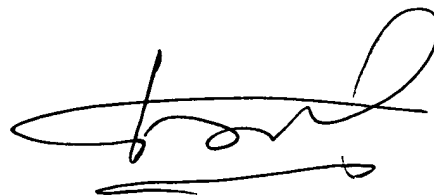
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner

Igor N. Borissov

IB  
1/24/2006

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a stylized flourish at the end.